

REMARKS

Reconsideration and allowance of the subject application are respectfully requested. Claims 2-7, 9-13, and 16 remain pending, claims 2 and 16 being independent.

In this reply, Applicant has cancelled claims 1, 8, 14, 15, and 17-19 without prejudice or disclaimer.

Prior Art Rejections

Claims 1-4, 7, and 14-17 stand rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Fredlund et al. (U.S. Patent 5,666,215, hereinafter "Fredlund '215"). Claim 5 stands rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Fredlund '215 in view of Tamura et al. (U.S. Patent 6,771,896, hereinafter "Tamura"). Claim 6 stands rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Fredlund '215 in view of Ueda et al. (U.S. Patent 6,429,923, hereinafter "Ueda"). Claims 8 and 9 stand rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Fredlund '215 in view of Motegi (U.S. Patent 6,307,640, hereinafter "Motegi"). Claim 10 stands rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Fredlund '215 in view of Motegi and further in view of Chui et al. (U.S. Patent 6,657,702, hereinafter "Chui"). Claims 11-13 stand rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Fredlund '215 in view of Motegi and further in view of Fredlund et al. (U.S. Patent 6,154,295, hereinafter "Fredlund '295"). These rejections, insofar as they pertain to the presently pending claims, are respectfully traversed.

Initially, Applicant notes that independent claim 2 has been amended to incorporate the features of dependent claim 8 (now cancelled) and that independent claim 16 has been similarly amended. Therefore, the following patentability arguments focus primarily on the Examiner's assertions that originally-presented dependent 8 is rendered unpatentable based on a combination of Fredlund '215 in view of Motegi.

Independent claim 2 is directed to a server computer capable of being connected to a communication terminal comprising a display device capable of displaying an image such that they can communicate with each other through a network. As amended, the server computer of claim 2 comprises: an image database storing image data; an image data transmission device for transmitting to said communication terminal the image data stored in said image database in

response to an image transmission request from said communication terminal; a storage device storing order information transmitted from said communication terminal and related to prints of an image represented by the image data transmitted by said image data transmission device; a controller controlling a printer so as to print the image represented by the image data specified on the basis of the order information stored in said storage device in response to the print command from said communication terminal; image data registration acceptance means for accepting the registration of the image data to be stored in the image database; and first ID generation means for generating an image ordering ID and a print commanding ID in correlation with the accepted image data in response to the acceptance of the image data by the image data registration acceptance means. The image transmission request transmitted from the communication terminal includes said image ordering ID. The image data transmission device transmits to said communication terminal the image data correlated with the image ordering ID in response to the image transmission request from the communication terminal. The print command transmitted from the communication terminal includes the print commanding ID. The printer controller controls the printer so as to print an image represented by the image data correlated with the print commanding ID in response to the print command from the communication terminal.

Thus, according to the present invention of claim 2, an image ordering ID and a print commanding ID are generated in response to the acceptance of image data. When the image ordering ID is transmitted to the server computer from the communication terminal, the server computer transmits image data correlated with the image ordering ID to the communication terminal, and stores the order information transmitted from the communication terminal. When the print commanding ID is transmitted to the server computer from the communication terminal, the server computer controls the printer so as to print the image represented by the image data correlated with the print commanding ID on the basis of the order information. The image ordering ID and the print commanding ID are IDs specifying the same image data and are both transmitted to the server computer from the communication terminal. The server computer is controlled to perform processing on the same image data on the basis of each of the two kinds of ID transmitted from the communication terminal.

In rejecting dependent claim 8, the Examiner cites column 3, lines 32-36 of Fredlund '215 as allegedly disclosing the generation of an image ordering ID, and further states that:

Fredlund '215 does not explicitly disclose a print commanding ID. However, the Motegi reference, discloses in Fig. 3 item S2, the registering of a job number. This can be a print commanding ID since it designates which job to print.

Initially, Applicant notes that the cited portion of Fredlund '215 does not disclose an image ordering ID, and instead discloses a customer order number, which Fredlund '215 does not disclose as being generated in response to the acceptance of image data.

Regarding Motegi, although this reference discloses a computer-based network printing system in which a job number is registered by a host computer and in which a network server, upon receiving a print request signal, sends a "related message to the host computer" (column 3, lines 46-50), Motegi does not disclose that this job number is generated in response to the acceptance of image data.

Accordingly, neither Fredlund '215 nor Motegi disclose or suggest "generating an image ordering ID... in response to the acceptance of the image data" as claimed. Furthermore, neither Fredlund '215 nor Motegi teach or suggest two kinds of IDs (an image ordering ID and a print commanding ID) in correlation with the accepted image data in response to the acceptance of the image data as claimed.

To establish *prima facie* obviousness, all claim limitations must be taught or suggested by the prior art and the asserted modification or combination of prior art must be supported by some teaching, suggestion, or motivation in the applied reference or in knowledge generally available to one skilled in the art. *In re Fine*, 837, F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Thus, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). The prior art must suggest the desirability of the modification in order to establish a *prima facie* case of obviousness. *In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1995). It can also be said that the prior art must collectively suggest or point to the claimed invention to support a finding of obviousness. *In re Hedges*, 783 F.2d 1038, 1041, 228 USPQ 685, 687 (Fed. Cir. 1986); *In re Ehrreich*, 590 F.2d 902, 908-09, 200 USPQ 504, 510 (CCPA 1979).

In view of the above, Applicant respectfully submits that the asserted combination of Fredlund '215 and Motegi (assuming these references may be combined, which Applicant does not admit) fails to establish *prima facie* obviousness of claim 2, or any claim depending therefrom. Independent claim 16, as amended, is believed to define over this asserted combination based on similar reasoning.

Applicant further submits that the Examiner's reliance on Tamura, Chui, and Fredlund '295 fails to make up for the above-noted deficiencies of the asserted Fredlund '215-Motegi combination.

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 103.

Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: March 21, 2006

Respectfully submitted,

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